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In re Application of
Tasuku HONJO, et al.
Application No.: 09/674,379
PCT No.: PCT/JP99/02284
Int. Filing Date: 28 April 1999
Priority Date: 28 April 1998
Attorney's Docket No.: Q61531
For: A NOVEL POLYPEPTIDE, A cDNA ENCODING THE POLYPEPTIDE AND UTILIZATION THEREOF

: DECISION ON REQUEST

: UNDER 37 CFR 1.497(d)

This decision is in response to the PETITION UNDER 37 C.F.R 1.48 TO CORRECT INVENTORSHIP filed 25 January 2002, hereinafter treated as a request to accept the declaration under 37 CFR 1.497(d).

BACKGROUND

On 28 April 1999, applicants filed international application PCT/JP99/02284, which claimed priority to Japanese application 10-119731, filed 28 April 1998. A Demand for international preliminary examination, in which the United States was elected, was filed 13 October 1999. Accordingly, the thirty month period for paying the basic national fee in the United States in accordance with 37 CFR 1.495(b), expired at midnight on 30 October 2000 (October 28th falling on a Saturday).

On 30 October 2000, applicants filed a Transmittal Letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee, but without an oath or declaration.

On 09 May 2001 the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration executed in compliance with 37 CFR 1.497 (a) and (b) was required, along with the $130.00 late Declaration surcharge and a $36.00 excess claim fee. The Notification set a two (2) month period for response from the mailing date of 09 May 2001 making response due 09 July 2001, with extension of time available under 37 CFR 1.136 (a).

On 10 December 2001, applicants submitted a "Response to Notification of Missing Requirements Under 35 U.S.C. 371" including a check for $166.00 ($130.00 late Declaration fee + $36.00 excess claim fee) and a petition for a (5) month extension of time along with the extension fee of $1960.00. The Response included, *inter alia*, a Declaration executed by the three (3) inventors named in the PCT application; but indicated that declaration signatures from six (6) additional inventors would be forthcoming along with a Petition to correct inventorship under 37 CFR 1.48(a).

On 25 January 2002 the present PETITION UNDER 37 C.F.R 1.48 TO CORRECT INVENTORSHIP was filed including:

(1) a request to correct the inventorship that sets forth the desired inventorship change, e.g. the addition of six (6) newly named inventors;

(2) a statement from each added inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) a declaration by the nine (9) named inventors; and

(4) the processing fee set forth in 37 CFR 1.17(i).

The petition further included a RECORDATION FORM COVER SHEET (Form PTO-1595) and an ASSIGNMENT conveying title from the nine actual inventors (assignors) to ONO PHARMACEUTICAL CO., LTD and GENETICS INSTITUTE, INC. (assignees).

DISCUSSION

As discussed above, the petition under 37 CFR 1.48 is treated as a request to accept the declaration under 37 CFR 1.497(d) which states the following:

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any declaration which was filed under PCT Rule 4.17(iv), the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in 37 CFR 1.17(i); and

(3) If an assignment has been executed by any of the original inventors, the written consent of the assignee (see 37 CFR 3.73(b)).

The request lacks item (3) above.

With regard to item (3), MPEP 201.03 at 200-8 (updated August 2001) states in part:

> The written consent of every existing assignee of the original named inventors must be submitted. 37 CFR 1.48(a)(5). 37 CFR 1.48(a) does not limit assignees to those who are recorded in the Patent and Trademark Office records. The Office employee deciding the request should check the file record for any indication of the existence of an assignee (e.g., a small entity statement from an assignee).

> Where no assignee exists requester should affirmatively state that fact. If the file record including the request is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert requesters to the requirement.
>
> The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record.
>
> A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity statement, it is also acceptable. Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP ' 324.

Furthermore, in the present case, the PETITION TO CORRECT INVENTORSHIP submitted 25 January 2002 included an assignment to ONO PHARMACEUTICAL CO., LTD and GENETICS INSTITUTE, INC. Additionally, the international application lists ONO PHARMACEUTICAL CO.,LTD as an applicant. Such designations appear to indicate a proprietary interest in ONO PHARMACEUTICAL CO., LTD and GENETICS INSTITUTE, INC. and create a presumption of the existence of two separate assignees. If such presumption is correct, the written consent of both assignees are required to satisfy 37 CFR 1.497(d). If such presumption is incorrect, petitioner should affirmatively state that no assignee(s) exist(s). Petitioner has not provided either the written consent of the assignee(s) or a statement that no assignee(s) exist.

CONCLUSION

For the reasons above, the request to accept the declaration under 37 CFR 1.497(d) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this request is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to provide the proper reply will result in abandonment of the present application. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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